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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,784	11/13/2001	Christopher A. Wiklof	1788-22-3	1821

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GRAYBEAL JACKSON HALEY LLP
155-108th Avenue N.E., Suite. 350
Bellevue, WA 98004-5901

EXAMINER

CHERRY, EUNCHA P

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

2/

Office Action Summary

Application No.

10/007,784

Applicant(s)

WIKLOF ET AL.

Examiner

EUNCHA P. CHERRY

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

It is found that the new restriction requirement is needed in light of the argument in the response filed on 9/8/05.

Therefore, the restriction mailed on 8/5/05 is withdrawn. Also, it is noted that the applicant fails to specify where in the specification have supports for the amendments to claims (filed on 2/28/05).

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to an apparatus, classified in class 359, subclass 212.
- II. Claims 10-14, drawn to an apparatus, classified in class 359, subclass 212.
- III. Claims 15-20, drawn to an apparatus, classified in class 359, subclass 212.
- IV. Claims 33-35, drawn to an apparatus, classified in class 359, subclass 212.
- V. Claim 38, drawn to an apparatus, classified in class 359, subclass 212.
- VI. Claim 39, drawn to an apparatus, classified in class 359, subclass 212.

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VII. Claim 40, drawn to an apparatus, classified in class 359, subclass 212.

VIII. Claim 44, drawn to an apparatus, classified in class 359, subclass 212.

IX. Claim 21, drawn to a method, classified in class 359, subclass 900.

X. Claims 26-29, 36, 37, 41 and 42, drawn to a method, classified in class 359, subclass 900.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-VIII and IX-X are related as apparatus and process for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case inventions IX and X are materially different process.

3. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the

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instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the permanent magnet is not claimed. The subcombination has separate utility such as a scanner.

4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with a permanent magnet. See MPEP § 806.05(d).

5. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with only first magnetic force. See MPEP § 806.05(d).

6. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with a permanent magnet. See MPEP § 806.05(d).

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7. Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with a permanent magnet. See MPEP § 806.05(d).

8. Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with a permanent magnet. See MPEP § 806.05(d).

9. Inventions I and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a scanner with a permanent magnet. See MPEP § 806.05(d).

10. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by

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itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the specific repelling is not claimed. The subcombination has separate utility such as application with claimed specific repelling.

11. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as non-motorized application. See MPEP § 806.05(d).

12. Inventions II and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as in application with element parallel to axis. See MPEP § 806.05(d).

13. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has

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separate utility such as non-motorized application. See MPEP § 806.05(d).

14. Inventions IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as non-motorized application. See MPEP § 806.05(d).

15. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as non-motorized application. See MPEP § 806.05(d).

16. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as non-motorized application. See MPEP § 806.05(d).

17. Inventions IV and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown

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to be separately usable. In the instant case, invention VI has separate utility such as non-motorized application. See MPEP § 806.05(d).

18. Inventions V and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as an application with parallel movement. See MPEP § 806.05(d).

19. Inventions VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as an application with parallel movement. See MPEP § 806.05(d).

20. Inventions VII and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as an application with parallel movement. See MPEP § 806.05(d).

21. Inventions IX and X are related as subcombinations disclosed as usable together in a single combination. The

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subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as generating a scanned beam. See MPEP § 806.05(d).

If applicant elects invention II, inventions V, VI and VII will be examined together.

If applicant elects invention III, inventions V, VI and VII will be examined together.

If applicant elects invention IV, inventions VI, VII and VIII will be examined together.

If applicant elects invention V, inventions VI and VII will be examined together.

If applicant elects invention VI, inventions VII will be examined together.

22. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for other Groups, restriction for examination purposes as indicated is proper.

23. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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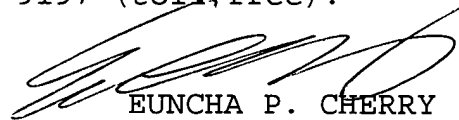
24. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EUNCHA P. CHERRY whose telephone number is 571-272-2310. The examiner can normally be reached on M-F 6:30-4:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DREW DUNN can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EUNCHA P. CHERRY
Primary Examiner
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11/28/05